

### **REMARKS**

Claims 1-7, 9, and 11-20 are pending in the present application. Claims 1 and 3 have been amended. Claim 2 has been cancelled, without prejudice. Support for the amendments herein presented can be found in the specification and claims as filed. No new matter has been introduced as a result of the amendments. Reconsideration and allowance is respectfully requested in view of the amendments and the following remarks.

#### **Record of Interview**

On March 7, 2003 an interview was conducted by telephone between the Examiner and the Applicant's representative, Nicole E. Coppes-Gathy, Reg. No. 46,640. The Examiner is thanked for granting this interview. The Final Office Action was discussed, particularly the rejection of Claim 1. The Applicant's representative proposed an amendment to Claim 1. The Examiner stated that he would need to see any proposed amendments. The proposed amendments are presented herein.

#### **The 35 U.S.C. § 112 Rejection**

Claim 2 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This objection is respectfully traversed.

Claim 2 has been cancelled, and therefore this rejection is moot. Reconsideration and withdrawal of this rejection is respectfully requested.

#### **The 35 U.S.C. § 103 Rejections**

Claims 1, 3-7, 9 and 11-20 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Dubin (U.S. Patent No. 5,284,492) in view of WO 95/27021 and Schwab (U.S. Patent 5,669,938). This rejection is respectfully traversed.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claim 1 has been amended to recite "said emulsion having an average droplet diameter of greater than 6 microns to about 10 microns". Dubin, WO 95/27021, and Schwab do not teach an "...emulsion having an average droplet diameter of greater than 6 microns to about 10 microns." Since the cited art does not teach every element of the claimed invention, the Examiner has failed to make a *prima facie* case of obviousness.

The argument and evidence set forth above is equally applicable here. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988). Since the independent Claim 1 is nonobvious, then the dependent Claims 3-7, 9, and 11-20 must also be nonobvious.

In view of the foregoing, it is respectfully requested that the rejection be withdrawn and it is respectfully asserted that the claims are now in condition for allowance.

Claims 1, 3-7, 9 and 11-20 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Peter-Hoblyn et al. (U.S. Patent No. 5,743,922) in view of WO 95/27021 and Schwab. This rejection is respectfully traversed.

As stated above, for an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the

prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

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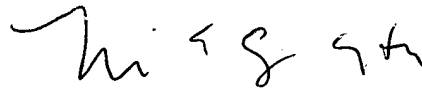
#### Request for Allowance

Entry of this Amendment will place the Application in better condition for allowance, or at the least, narrow any issues for an appeal. Accordingly, entry of this Amendment is appropriate and is respectfully requested.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,  
SIERRA PATENT GROUP, LTD.

Dated: March 13, 2003



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